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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/533,325	03/22/2000	Nimrod Megiddo	ARC000009US1-IBM	7964
33360	7590	10/19/2006	EXAMINER	
MARK D. MCSWAIN IBM ALMADEN RESEARCH CENTER, IP LAW DEPT. 650 HARRY ROAD CHTA/J2B SAN JOSE, CA 95120			VIG, NARESH	
			ART UNIT	PAPER NUMBER
			3629	
DATE MAILED: 10/19/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/533,325

Applicant(s)

MEGIDDO, NIMROD

Examiner

Naresh Vig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4,9,10,12,13,15,16,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,9,10,12,13,15,16,21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

This is in reference to Notice of Withdrawal mailed 20 July 2006. Claims 1, 4, 9-10, 12-13, 15-16 and 21-22 are pending for examination.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 4, 9-10, 12-13, 15-16 and 21-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention manages contingent contracts by retrieving information related to contingencies, notifies parties involved in the contract when the contingencies are met used in determining when the contingencies are satisfied for the contract to be complete.

Although the recited process produces a useful result (determining whether the contingencies are met), however, the claimed invention does not produce concrete and tangible results because the claimed invention does not positively claim how the retrieved information from plurality of independent sources is used to determine whether the agreement is determinate because applicant has not positively grouped the

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independent sources with the transaction. As currently claimed by the applicant, a retrieved information from an independent contractor who may have worked on another unrelated property may be used to make the determination of the agreement between a buyer and a seller. The claimed invention , as a whole, is directed to non-statutory subject matter because it does not produce concrete and tangible results.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4, 9-10, 16 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are:

Identifying independent sources with an agreement.

Identifying independent source(s) with each one of the conditions in the agreement.

Retrieving information related to a contingency from the identified independent source(s).

Updating the status of the contingency after checking the retrieved information reflecting whether the contingency is satisfied or not satisfied.

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Claims 12, 13, 15 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are:

Means for identifying independent sources with an agreement.

Means for identifying independent source(s) with each one of the conditions in the agreement.

Means for retrieving information related to a contingency from the identified independent source(s).

Means for updating the status of the contingency after checking the retrieved information reflecting whether the contingency is satisfied or not satisfied.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 9-10, 12-13, 15-16 and 21-22 are rejected under 35 U.S.C. 102(e) as being unpatentable over Mini et al. US Patent 6,684,196

Regarding claims 1 and 16, Mini teaches commerce management method for automatically managing agreements including one or more contingencies. Mini teaches:

logging at least one condition for an agreement (e.g. home inspection) [Mini, Fig. 18, 1822, and disclosure associated with Fig. 19] and identifying at least one potential response as indicating satisfaction of said at least one condition (customer accepting the results of home inspection) [Mini, Fig 20, 2008, and disclosure associated with Fig. 20];

retrieving information related to responses to each condition from independent sources [Mini, Fig. 19, 1922, and disclosure associated with Fig. 19];

checking said retrieved information to determine whether said agreement is determinate (customer accepting the results of home inspection) [Mini, Fig 20, 2008, and disclosure associated with Fig. 20]; and

notifying contracting parties when said agreement is determined to be determinate (customer gets update on contingencies) [Mini, Fig 20, 2034, and disclosure associated with Fig. 20].

Regarding claim 4, Mini teaches capability for automatically retrieving information from previously identified remotely connected locations [Mini, Fig. 19, 1922, and disclosure associated with Fig. 19].

Regarding claim 9, Mini teaches capability of notifying the parties that the contract has failed when a response to a condition indicates said condition cannot be satisfied (customer not accepting the results of the home inspection). Mini teaches

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notifying e-mails are generated for involved parties [Mini Fig. 18 and disclosure associated with Fig. 18].

Regarding claim 10, Mini does not explicitly teach notifying the parties that the contract is determinate when identified satisfying responses have been received for each said condition. However, as responded to earlier, Mini teaches capability for notifying parties involved in a transaction. However, when there is only one contingency in a contract, it is inherent that Mini notifies parties involved in the transaction that the contract is determinate (for example, receiving of escrow deposit, acceptance of the results of the home inspection etc.)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made that Mini is capable of notifying the parties that the contract is determinate to inform the parties involved to proceed with the closing process.

Regarding claim 21, Mini does not explicitly teach retrieved information to include a mortgage rate. However, Mini teaches customers can apply for loans using their invention.

Therefore, it is inherent that for processing loan mortgage rate is communicated to the borrower to comply with Truth in Lending requirements.

Regarding claim 12, as responded to earlier, Mini teaches:

a plurality of remotely connected terminals, contracting parties entering information about contract conditions in said terminals;

a storage maintaining a contingency agreement database, said contingency agreement database including contracting party information and condition information on a plurality of agreements, said condition information including [Mini, Fig. 18-19 and disclosure associated with Fig. 18-19]:

one or more potential responses satisfying each condition (acceptance of home inspection by buyer, buyer cancels the contract etc.), and one or more milestones for each said potential response (buyer proceeds with the purchase of the property, buyer cancels the contract as starts looking for another property); and

an automatic data retriever retrieving condition response information from independent sources via one or more remotely connected computers [Mini, Fig. 19, 1922, and disclosure associated with Fig. 19].

Regarding claim 13, as responded to earlier, Mini teaches capability of notifying contracting parties when a corresponding agreement is determinate [Mini Fig. 18 and disclosure associated with Fig. 18].

Regarding claim 15, Mini teaches capability wherein mailer sends electronic mail (e-mail) to parties identified by an e-mail address (inherent that email is sent to parties using their email addresses) [Mini Fig. 18 and disclosure associated with Fig. 18].



Regarding claim 22, Mini does not explicitly teach retrieved information to include a mortgage rate. However, Mini teaches customers can apply for loans using their invention.

Therefore, it is inherent that for processing loan mortgage rate is communicated to the borrower to comply with Truth in Lending requirements.

### ***Conclusion***

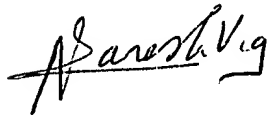
Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Naresh Vig  
Examiner  
Art Unit 3629



John Weiss  
SPE  
Art Unit 3629

October 10, 2006